2624/44

In re Application of: HIROSHI KAJIWARA

Docket No. 03500.012124.

Application No.: 09/827,925

Examiner: W. Chen

Filed: April 9, 2001

Group Art Unit: 2624

For: IMAGE ENCODE APPARATUS, IMAGE ENCODE METHOD AND STORAGE MEDIUM

Date: April 19, 2002

THE COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

Transmitted herewith is a Response To Official Action in the above-identified application.

[X] No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	* 13	MINUS	** 13	= 0	x $9 $18	0
INDEP. CLAIMS	* 6	MINUS	*** 6	= 0	x $42 $84	0
Fee for Multiple Dependent claims $140/$280						
			TOTAL ADDITIONAL FEE FOR THIS AMENDMENT---			0

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

[ ] Verified Statement claiming small entity status is enclosed, if not filed previously.

☐ A check in the amount of $_____ is enclosed.

☐ Charge $_____ to Deposit Account No. 06-1205. A duplicate copy of this sheet is enclosed.

☒ Any prior general authorization to charge an issue fee under 37 C.F.R. 1.18 to Deposit Account No. 06-1205 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 06-1205. A duplicate copy of this paper is enclosed.

☒ A check in the amount of $ 920.00 to cover the fee for a three-month extension is enclosed.

☐ A check in the amount of $_____ to cover the Information Disclosure Statement fee is enclosed.

☒ Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

Attorney for Applicant

Registration No. 44,063

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03500.012124. PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: W. Chen
HIROSHI KAJIWARA	)	
	:	Group Art Unit: 2624
Appln. No.: 09/827,925	)	
	:	
Filed: April 9, 2001		
	:	
For: IMAGE ENCODE APPARATUS IMAGE ENCODE METHOD AND STORAGE MEDIUM	) :)	April 19, 2002

The Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO OFFICIAL ACTION
AND
PETITION FOR EXTENSION OF TIME

Sir:

In response to the Office Action of October 19, 2001, Applicant petitions to extend the time for taking further response to April 19, 2001. A check in the amount of $920.00 in payment of the extension fee is enclosed. Please charge any additional fee and credit any overpayment to our Deposit Account 06-1205.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: The Commissioner for Patents, Washington, D.C. 20231 on April 19, 2002.
(Date of Deposit)

RAYMOND A. DiPERNA
(Name of Attorney for Applicant)

Signature

April 19, 2002
Date of Signature

04/29/2002 BABRAHA1 00000013 09827925
01 FC:117 920.00 OP

Claims 1-13 are presented for examination. Claims 1, 7-9, 12, and 13 are independent.

Applicants note that Claims 9-13 have been allowed.

The application has been objected to under 37 C.F.R. § 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. In order to overcome this objection, Applicant is in the process of obtaining the proper signature on a form entitled **Assent of Assignee to Reissue Under 37 C.F.R. § 1.172**, and Applicant will submit this form by way of a Supplemental Response as soon as possible.

The application has also been objected to under 37 C.F.R. § 1.172(a) because the assignee has not established its ownership interest in the patent for which reissue is being requested. In order to overcome objection, Applicant is in the process of obtaining the proper signature on a form entitled **Assignee Statement Under 37 C.F.R. § 3.73(b)**, and Applicant will submit this form by way of a Supplemental Response as soon as possible.[1/]

Claims 1-8 have been rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Office Action states that a broadening aspect is present in the reissue which was not present in the application for patent, and that the record of the application for the patent shows that the broadening aspect (in the reissue)

1/During a conversation between Applicant's representative and Krista Zele, an SPE in Technology Center 2600, Ms. Zele tentatively agreed that a statement by Applicant's attorney that these forms would be submitted in a Supplemental Response would be a bona fide response to the outstanding objections.

relates to subject matter that the Applicant previously surrendered during the prosecution of the application. Accordingly, the Office Action reasons, "the narrow scope of the claims in the patent was not an error within the meaning of Section 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application."

In the original application 08/874,581, the Examiner provided the following reasons for allowance of Claims 18, 24, and 25 of the original application, which were renumbered as Claims 1, 7, and 8 in the issued patent 6,028,963:

> "The prior art fails to teach apparatus of Claim 18, method of Claim 24, and medium of Claim 25 which specifically comprise the limitations of:
>
> --judging an appearing prediction error difference and an unappearing prediction error difference on the basis of the first prediction error difference, and for encoding the second prediction error difference on the basis of the judged appearing and unappearing prediction error differences, wherein the second prediction error difference is not used in the judging operation;
>
> –changing a first relationship between prediction error difference and encoding data to a second corresponding relationship between prediction error difference and encoding data according to a result obtained in the judging operation."

The Office Action further states that, in the above reasons for allowance of the original application, the Examiner specifically pointed out that the combination of the two listed limitations, each in whole not in part, distinguishes the original Claims 18, 24, and 25 over the teachings of the prior art. The Office Action also states that Applicant did

not present on the record in that application a counter statement or comment as to the Examiner's reasons for allowance, and permitted the claims to issue with the above limitations. Therefore, it is reasoned in the Office Action, limitations omitted from the present reissue claims (relative to the patent claims) are "established as relating to subject matter previously surrendered" and independent Claims 1, 7, and 8 and dependent Claims 2-6 of the reissue application are rejected as being an improper recapture of previously surrendered subject matter, owing to their non-inclusion of those limitations. Applicant now offers the following comments in response to that rejection.

In a recent opinion, *Pannu vs. Storz Instruments, Inc.*, 258 F.3d 1366, 2001 U.S. App. LEXIS 16645 (Fed. Cir. 2001), the Court of Appeals for the Federal Circuit defined the recapture test as having three parts. The first part of the test is to determine whether and in what aspect the reissue claims are broader than the patent claims, the second part involves determining whether the broader aspects of the reissue claims relate to surrendered subject matter,[2/] and the third part of the test is to determine whether the reissue claims were materially narrowed in other respects to avoid the recapture rule.[3/] (see also MPEP § 1412.02).

The language of the claims being deleted in the reissue application is the language of the judging means/step (see Claims 1, 7, and 8) reciting "encoding the second

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2/ *Id.* ((*quoting In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997) (*quoting Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993))).

3/ *Id.* (*citing Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998); *In re Clement*, 131 F.3d at 1470).

prediction error difference on the basis of the judged appearing and unappearing prediction error differences." Applicant respectfully submits that, while the scope of those reissue claims appears at first glance to be broader than the original patent claims, which recited the above language, the reissue claims at issue are not broader than the corresponding patent claims in at least one respect, because, for the reasons given below, the deleted features are in effect redundant of the encoding means/step already recited in last paragraph of Claims 1, 7, and 8. For example, while the language proposed to be deleted from Claims 1, 7, and 8 recites, in part, "encoding the second prediction error difference on the basis of the judged appearing and unappearing prediction error differences", and the encoding means/step of Claims 1, 7, and 8 (of the original patent and reissue application) recites, in part, "encoding the second prediction error difference on the basis of [a selected] one of the first and second corresponding relationships to obtain corresponding encoding data," a review of the overall recitations of Claims 1, 7, and 8 reveals that both encodings are performed in essentially the same way -- i.e., based on appearing and unappearing prediction error differences. That is, since the "first corresponding relationship" (between prediction error difference and encoding data) is changed to the "second corresponding relationship" according to a result obtained by the judging means/step, and the judging means/step judges "an appearing prediction error difference and an unappearing prediction error difference on the basis of the first prediction error difference," then essentially the same encoding function as recited in the deleted language is performed (i.e., based on appearing and unappearing prediction error differences). Thus, the language proposed to be deleted from the judging means/step of Claims 1, 7, and 8 in this reissue application is

merely redundant of the encoding means/step already recited in the last paragraph of Claims 1, 7, and 8.

In at least this respect, the scope of the reissue claims is not being broadened relative to the patent claims, and Applicant respectfully submits that the present reissue application is being presented merely to remove one of the redundant limitations from the patent claims, not to recapture any subject matter, let alone any previously surrendered subject matter.

Moreover, in application 08/874,581, Applicant did not, and could not, have surrendered the subject matter at issue, since the mentioned encoding means/step of Claims 1, 7, and 8, which reads on that subject matter, never was amended, canceled, or argued in the original application to overcome a rejection or objection in that application. See MPEP 1412.02 (if a limitation omitted from a reissue claim was originally presented/argued/stated in the original application to make the claims allowable *over a rejection or objection* made in the original application, the omitted limitation relates to previously surrendered subject matter).[4/]

For all of these reasons, Applicant submits that Claims 1-8 are not an improper recapture of any previously surrendered subject matter, and thus the withdrawal of the rejection under Section 251 is respectfully requested.

In view of the foregoing remarks, Applicant respectfully requests favorable

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4/ Indeed, in the Examiner's reasons for allowing application 08/874,581, noted in the present Office Action, no mention whatsoever is made that the specific recitations of the encoding means/step of Claims 18, 24, and 25 (Claims 1, 7, and 8 of the patent) were considered by the Examiner as being germane to the allowability of those claims.

reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

Attorney for Applicant

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